

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: October 20, 2022

Mailed: January 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Chatam International Incorporated
—

Serial No. 90114379
—

Anthony Giaccio of Giaccio LLC,
for Chatam International Incorporated.

Robert N. Guliano, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

—
Before Kuhlke, Goodman and Lebow,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Chatam International Incorporated (“Applicant”) seeks registration on the Principal Register for the mark STRONG ISLAND in standard characters for services ultimately identified as “Alcoholic beverages, except beer” in International Class 33.¹ The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s

¹ Application Serial No. 90114379, filed on August 14, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an allegation of an intent to use the mark in commerce.

mark, when used in connection with the identified goods, so resembles STRONG ISLAND ALE in standard characters (ALE disclaimed) for “beer, ale, lager, stout and porter” in International Class 32² registered on the Supplemental Register, as to be likely to cause confusion.

When the Section 2(d) refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request, the appeal was resumed and briefed. We affirm the refusal to register.³

I. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc.*

² Registration No. 5298511, issued on September 26, 2017.

³ Citations to TTABVUE throughout the decision are to the Board’s public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO’s online Trademark Status and Document Retrieval system (TSDR).

v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all [*DuPont*] factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity/Dissimilarity of the Marks

We compare the marks in their entireties as to “appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

In comparing Applicant’s mark STRONG ISLAND with Registrant’s mark STRONG ISLAND ALE the similarities are self-evident. Registrant’s mark begins with the entirety of Applicant’s mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“The identity of the marks two initial words is particularly significant because consumers typically notice those words first”). The additional word ALE in Registrant’s mark is simply the name of the goods; it has no

source-identifying significance. *Id.* at 1050 (“the non-source identifying nature of the words ‘Co.’ and ‘Club’ and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis”). In addition, because Applicant’s and Registrant’s marks are in standard characters, they are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). We must therefore consider Applicant’s and Registrant’s marks “regardless of font style, size, or color,” *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011), including iterations that emphasize the common element STRONG ISLAND and de-emphasize the element ALE. Thus, the addition of the word ALE to the end of Registrant’s mark is not sufficient to outweigh the similarities in appearance and sound.

Applicant argues that the addition of the word ALE to Registrant’s mark significantly alters the connotation and commercial impression of the mark in a manner that distinguishes it sufficiently from Applicant’s mark. Specifically, Applicant argues that “the term ALE ... narrowly limits the public’s perception of the mark as a whole to ALE” and “a reasonably prudent consumer would not expect the Cited Mark, STRONG ISLAND ALE, to be used to sell alcoholic beverages except beer, such as wine, vodka, rum, etc. in Class 33, because the mark itself conveys to

the public the specific connotation and commercial impression of ‘ale.’” App. Brief, 8 TTABVUE 6-7.

We are not persuaded. Using Applicant’s logic, the absence of a product identifier in Applicant’s mark, STRONG ISLAND, should cause consumers to expect it is used with all alcoholic products, including beer, which undercuts Applicant’s argument that the marks are sufficiently dissimilar in connotation and commercial impression to avoid confusion. Thus, the question is not whether Applicant use its mark on beer and ale, or Registrant will not use its “ALE” mark on anything other than beer and ale, but rather whether, seeing Applicant’s mark on vodka or wine, consumers could mistakenly assume it is the same source as the beer and ale sold under the mark STRONG ISLAND ALE. As the Examining Attorney explains, Applicant’s mark looks like a shortened version of Registrant’s mark for use on other alcohol products.

We bear in mind that the “marks ‘must be considered . . . in light of the fallibility of memory.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ2d 1, 3 (CCPA 1977)). While a close side-by-side comparison of the marks could reveal the slight differences between them, that is not the proper way to determine likelihood of confusion, as that is not the way customers will view the marks in the marketplace. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *see also In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983) and cases cited therein; *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016). To customers in the

marketplace, the marks have a similar appearance and sound, and would convey a similar connotation and commercial impression. In terms of appearance, sound, connotation, and commercial impression, we find the similarity of the marks — considered in their entireties — outweighs their dissimilarity. In view thereof, the similarity of these marks weighs in favor of a finding of likelihood of confusion.

B. Relatedness of the Goods, Trade Channels, and Classes of Consumers

When considering the goods, trade channels and classes of consumers, we must make our determinations based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”). In order to support a finding of a likelihood of confusion, it is sufficient that the types of goods of an applicant and registrant are related in some manner or that the conditions surrounding the marketing of these types of goods are such that they are likely to be encountered by the same persons under circumstances that, because

of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000).

In support of the Office's position, the Examining Attorney submitted printouts from several third-party websites, arguing they show that "Alcoholic beverages, except beer" and "beer, ale, lager, stout and porter" are "commonly offered by the same source, under the same mark, and in the same trade channels." Ex. Att. Brief, 10 TTABVUE 6. The examples as presented in the Examining Attorney's brief are summarized below:

- *Little Toad Creek* December 10, 2020, First Office Action, TSDR pp. 2-3 (LITTLE TOAD CREEK for beer and canned cocktails)
- *Dogfish Head* December 10, 2020, First Office Action, TSDR pp. 4-5 (DOGFISH HEAD for beer and vodka)
- *Gervasi* December 10, 2020, First Office Action, TSDR pp. 6-8 (GERVASI for beer and wine)
- *St. Clair Brown* July 13, 2021, Final Office Action, TSDR pp. 2, 5 (ST. CLAIR BROWN for beer and wine)
- *Nimble Hill* July 13, 2021, Final Office Action, TSDR pp. 6-7 (NIMBLE HILL for beer and wine)
- *Round Barn* July 13, 2021, Final Office Action, TSDR pp. 11-12 (ROUND BARN for beer and sangria)

- *Copp* July 13, 2021, Final Office Action, TSDR pp. 20-24 (COPP for beer and wine)
- *Superior Coast* July 13, 2021, Final Office Action, TSDR pp. 25-28 (SUPERIOR COAST for beer and wine and hard cider)
- *Village Vintner* July 13, 2021, Final Office Action, TSDR pp. 38-41 (VILLAGE VINTNER for beer and wine)
- *Abbey* July 13, 2021, Final Office Action, TSDR pp. 42-43 (ST. CLAIR BROWN for beer and wine)
- *Outlook Farm* July 13, 2021, Final Office Action, TSDR p. 44 (OUTLOOK FARM for beer and wine and hard cider)
- *Great Valley* July 13, 2021, Final Office Action, TSDR pp. 45-47 (valley and foothill design for beer and wine)
- *Keel Farms* July 13, 2021, Final Office Action, TSDR p. 53 (KEEL FARMS for beer and hard cider)
- *Karbach* July 13, 2021, Final Office Action, TSDR pp. 54-55 (KARBACH for beer and hard seltzer)
- *Corona* July 13, 2021, Final Office Action, TSDR pp. 56-57 (CORONA for beer and hard seltzer)
- *Pabst* July 13, 2021, Final Office Action, TSDR pp. 58-60 (PABST for beer and whiskey and hard seltzer)
- *Funky Buddha* July 13, 2021, Final Office Action, TSDR pp. 61-63 (FUNKY BUDDHA for beer and hard seltzer)

- *Breckenridge Brewery* July 13, 2021, Final Office Action, TSDR pp. 67-68 (BRECKENRIDGE BREWERY or beer and hard seltzer)
- *10Barrel* July 13, 2021, Final Office Action, TSDR pp. 70-71 (10BARREL for beer and canned cocktails)
- *Oskar Blues* July 13, 2021, Final Office Action, TSDR pp. 72-73 (OSKAR BLUES for beer and hard seltzer)
- *Rogue* July 13, 2021, Final Office Action, TSDR pp. 74-75 (ROGUE for beer and canned cocktails)
- *New Realm* July 13, 2021, Final Office Action, TSDR pp. 76-78 (NEW REALM for beer and canned cocktails)
- *4Sons* July 13, 2021, Final Office Action, TSDR pp. 79-81 (4SONS for beer and canned cocktails)
- *Devils Backbone* July 13, 2021, Final Office Action, TSDR pp. 82-83 (DEVILS BACKBONE for beer and canned cocktails)
- *Harpoon* July 13, 2021, Final Office Action, TSDR pp. 84, 87-88 (HARPOON for beer and hard cider)
- *Ommegang* July 13, 2021, Final Office Action, TSDR pp. 85-86, 89 (OMMEGANG for beer and wine)
- *Appalachian Mountain* July 13, 2021, Final Office Action, TSDR p. 90 (APPALACHIAN MOUNTAIN for beer and hard cider)
- *Bud Light* July 13, 2021, Final Office Action, TSDR pp. 93-94 (BUD LIGHT for beer and hard seltzer)

- *Coors Light* July 13, 2021, Final Office Action, TSDR pp. 91, 98 (COORS LIGHT for beer and hard seltzer)
- *Natural Light* July 13, 2021, Final Office Action, TSDR pp. 99-100 (NATURAL LIGHT for beer and hard seltzer)
- *Michelob Ultra* July 13, 2021, Final Office Action, TSDR pp. 101-102 (MICHELOB ULTRA for beer and hard seltzer)
- *Goose Island* February 10, 2022, Reconsideration Letter, TSDR pp. 4-5 (GOOSE ISLAND for beer and craft cocktails)
- *Heretic* February 10, 2022, Reconsideration Letter, TSDR pp. 6-7 (HERETIC for beer and spirits)
- *Two Brothers* February 10, 2022, Reconsideration Letter, TSDR pp. 8-9 (TWO BROTHERS for beer and spirits)
- *10Torr* February 10, 2022, Reconsideration Letter, TSDR p. 10 (10TORR for beer and spirits)
- *Ninkasi* February 10, 2022, Reconsideration Letter, TSDR p. 11-14 (NINKASI for beer and canned cocktails)
- *Maplewood Brew* February 10, 2022, Reconsideration Letter, TSDR pp. 17-18 (M with design for beer and whiskey)

The examples of third-party use show that in the marketplace, consumers are exposed to the same mark used for the respective goods, indicating a single source for both and an overlap in trade channels and classes of consumers. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys.*

Corp., 91 USPQ2d 1266, 1272-73 (TTAB 2009) (website evidence shows same or overlapping channels of trade).

Applicant's arguments do not persuade us of a different result. Contrary to Applicant's contentions, the Examining Attorney has not applied a per se rule but rather has provided sufficient evidence of use in the marketplace to demonstrate consumer exposure to the respective goods being offered under the same mark in the same trade channels. In particular, Applicant asserts that "[t]he number of examples cited in support of the examining attorney's position is a relatively small number given the number of craft breweries and beer brands in the US." App. Reply Brief, 11 TTABVue 7. However, some of the examples of use are not from craft breweries, and heavily support the exposure of consumers to the same mark for the respective goods. *See, e.g.*, the Coors, Budweiser, and Michelob examples.⁴ Applicant's argument that the goods are different because of the difference in alcohol level is misplaced. For example, the type of goods covered by Applicant's identification of "alcoholic beverages, excluding beer" includes hard seltzer beverages, regardless of their alcohol level.

Applicant relies on the Board's unpublished decision in *Patron Spirits International AG v. Conyngham Brewing Company*, Opposition No. 91226939 (June 8, 2018) to support its position that the goods are not related. However, that case presented very different facts and findings than the those presented here. The marks PYRAT versus PIRATE PISS were found to have different connotations and

⁴ July 13, 2021 Office Action, TSDR pp. 93-102.

commercial impressions. In addition, the record had a handful of third-party registrations to show relatedness of goods, whereas here, there are multiple examples of use in the marketplace, not only by smaller companies but by large multinational companies such as Coors and Budweiser.

Here, the relatedness of the goods, and overlap in trade channels and classes of consumers weigh in favor of finding a likelihood of confusion.

C. No Actual Confusion

Applicant also asserts, without evidentiary support and for the first time in its brief, that although the application is based on bona fide intent to use the mark, it has in fact been in use in commerce since July 2021. Specifically, Applicant contends that its products have “coexisted with Registrants’ products without any objection or instance of confusion for ten months,” which “indicates that consumer are capable of distinguishing between the two marks without confusion.” App. Brief, 8 TTABVUE 15. We first observe that, attorney argument is not a replacement for evidence. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002 (TTAB 2014).

The question of actual confusion is addressed in the factors looking at the “nature and extent of any actual confusion” and the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. As to the factor looking at the nature and extent of any actual confusion, uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *Majestic Distilling*, 65 USPQ2d at 1205. See also *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973)

(stating that self-serving testimony of appellant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). Moreover, in the context of an ex parte appeal, there is no opportunity to hear from the registrant about whether it is aware of any reported instances of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”) (citations omitted).

As distinct from our analysis as to the similarity or dissimilarity of the goods, channels of trade, and relevant consumers, which are based on the identifications as set forth in the application and the cited registration, the factor considering the absence of evidence of actual confusion, by contrast – “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *see DuPont*, 177 USPQ at 567 – requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, *6 (TTAB 2020). Here, there is no evidence that in the actual marketplace, the same consumers have been exposed to both marks for the respective goods, such that we could make a finding as to the “length of time during

and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567.

In any event, “the test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion.” *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439-40 (TTAB 2006); *see also Detroit Athletic Co.*, 128 USPQ2d at 1053 (“[T]he relevant test is likelihood of confusion, not actual confusion.”) (emphasis in original); *i.am.symbolic*, 123 USPQ2d at 1747 (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion.”) (quoting *Herbko Int’l.*, 64 USPQ2d at 1380).

II. Conclusion

In sum, we hold that because the marks are similar, the goods are related, and the trade channels and classes of consumers overlap, confusion is likely between Applicant’s STRONG ISLAND mark and Registrant’s STRONG ISLAND ALE mark.

Decision: The refusal to register Applicant’s mark is affirmed under Trademark Act Section 2(d).